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09/603,306	06/23/2000	Brian Wolfe	5053-36200	1775

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,306

Applicant(s)

WOLFE, BRIAN

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 23 May 2003. Claims 1-56 remain pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 9, 16-20, 25, 30-34, 39, 46-49, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711 in view of Kuwamoto et al, U.S. Patent Number 5, 483, 632 for substantially the same reasons given in the previous Office Action (paper number 6). Further reasons appear hereinbelow.

(A) Claims 1-4, 9, 16-20, 25, 30-34, 39, 46-49, 56 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 6, section 3, pages 2-9), and incorporated herein.

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4. Claims 5, 11-13, 15, 21, 27-29, 35, 41-43, 45, 50, 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711 in view of Kuwamoto et al, U.S. Patent Number 5, 483, 632 as applied to claim 1 above, and further in view of Ertel, U.S. Patent Number 5, 307, 262 for substantially the same reasons given in the previous Office Action (paper number 6). Further reasons appear hereinbelow.

(A) Claims 5, 11-13, 15, 21, 27-29, 35, 41-43, 45, 50, 53-55 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 6, section 4, pages 9-11), and incorporated herein.

5. Claims 6, 22, 36, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711 in view of Kuwamoto et al, U.S. Patent Number 5, 483, 632 as applied to claim 1 above, and further in view of Winans, U.S. Patent Number 5, 307, 265 for substantially the same reasons given in the previous Office Action (paper number 6). Further reasons appear hereinbelow.

(A) Claims 6, 22, 36, 51 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 6, section 5, pages 11-12), and incorporated herein.

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6. Claims 7-8, 23-24, 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711 in view of Kuwamoto et al, U.S. Patent Number 5, 483, 632 as applied to claim 1 above, and further in view of McGauley, U.S. Patent Number 5, 899, 998 for substantially the same reasons given in the previous Office Action (paper number 6). Further reasons appear hereinbelow.

(A) Claims 7-8, 23-24, 37-38 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 6, section 6, pages 12-13), and incorporated herein.

7. Claims 10, 14, 26, 40, 44, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711 in view of Kuwamoto et al, U.S. Patent Number 5, 483, 632 as applied to claim 1 above, and further in view of Abbruzzese, U.S. Patent Number 5, 557, 515 for substantially the same reasons given in the previous Office Action (paper number 6). Further reasons appear hereinbelow.

(A) Claims 10, 14, 26, 40, 44, 52 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 6, section 7, pages 13-15), and incorporated herein.

Response to Arguments

8. Applicant's arguments filed 23 May 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 23 May 2003.

(A) At page 13 of the 23 May 2003 response, Applicant apparently argues that a *prima facie* case of obviousness has not been established.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 6). Note, for example, the motivations explicitly stated at lines 9-13 of page 4 of the previous Office Action (i.e., "...with the motivation of providing a method and a system of help-information control whereby ...") and at lines 8-14 of page 10 of the prior Office Action (i.e., "...with the motivation of managing the process of improving the quality and accuracy of reportable insurance claims data ...").

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Simply stated, what distinctions, if any, are there between Applicant's recited insurance claims processing program generating a request to display a message, wherein the request comprises a requested message code, and displaying the matching message text corresponding to the requested message code wherein the message text is configured to assist a user in processing an insurance claim using the insurance claims processing program, and the corresponding elements of the Huffman, Kuwamoto, Ertel, Winans, McGauley and Abbruzzese references? Also, arguments or conclusions of Attorney cannot take the place of evidence. In *re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

(B) At page 13-16 of the 23 May 2003 response, Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the features discussed by Applicant in the 23 May 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Huffman, Kuwamoto, Ertel, Winans, McGauley and Abbruzzese, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in

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the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 6), and incorporated herein. In particular, Examiner notes that the recited features of an insurance claims processing system are taught by the combination of applied references.

With regard to Applicant's argument that the references do not suggest or imply an insurance claims processing program generating a request to display a message, wherein the request comprises a requested message code and displaying the matching message text, Examiner notes that the combined references of Huffman, Kuwamoto, Ertel, Winans, McGauley and Abbruzzese and the knowledge generally available to one of ordinary skill in the art suggests or implies an insurance claims processing system comprising the recited claim.

(C) At pages 17-20 of the 23 May 2003 response, Applicant analyzes the applied references separately and argues each of the references individually.

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

And modern case law has clearly and explicitly held that in order for the references to be combined the references need not explicitly teach or suggest every element of the combination as well as how to use such a combination. For example, the Court in *In re Fritch* stated "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. [emphasis added]" *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Each applied reference does not expressly suggest combination with the other respective references; however, both the Board and the Examiner have shown that motivation for combining the references existed in the prior art. The "modification" referred to in *In re Fritch* involves extensive changes to the primary references. Such is not the case in the present combinations, where all modifications proposed by the Board and the Examiner are taught by the references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection maintained.

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Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160

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USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In response to Applicant's argument that Applicant's claims are directed to an insurance claims processing program, whereas the applied reference teaches processing cargo claims or "requests for remuneration for lost or damaged goods", Examiner respectfully submits that Merriam Webster Dictionary defines claim (noun) as "a demand for something due or believed to be due (insurance claim)": URL: <<http://www.m-w.com/cgi-bin/dictionary>> and, additionally, Dictionary.com defines claim as a "demand for payment in accordance with an insurance policy or other formal arrangement": URL: <<http://dictionary.reference.com/search?q=claims>>. Huffman's teachings of a method and system of processing cargo claims is thus an insurance claims processing system. Furthermore, although the Description Of Related Art section of

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Applicant's specification discusses bodily injury claims, this specific type of insurance is not recited in the broad limitations of claim 1.

With regard to Applicant's argument that the references do not suggest or imply the generation of messages to aid in the processing of an insurance claim, and "displaying messages to a user of an insurance processing system where the message text is 'configured to assist a user in processing an insurance claim'", Examiner notes that the combined references of Huffman, Kuwamoto, Ertel, Winans, McGauley and Abbruzzese and the knowledge generally available to one of ordinary skill in the art suggests or implies an insurance claims processing system comprising the recited limitations.

Moreover, the issue at hand is not whether the applied references specifically teach each and every feature recited by Applicant, per se, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art would put the artisan in possession of the features as claimed. With regard to this issue, the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. In re Graves, 36 USPQ 2d 1697 (Fed. Cir. 1995)

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(D) At pages 20-24 of the 23 May 2003 response, Applicant requests that the dependent claims be considered "separately" for patentability. In response, all of the limitations which Applicant disputes as missing in the applied references, including the features discussed by Applicant in the 23 May 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Huffman, Kuwamoto, Ertel, Winans, McGauley and Abbruzzese, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 6), and incorporated herein.

Conclusion

9. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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10. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

np

Natalie A. Pass

July 28, 2003


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600